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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/851,903	05/09/2001	Patrick Leon Spain	45215/WGM/A23	3955

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EXAMINER

JUSKA, CHERYL ANN

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 03/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/851,903

Applicant(s)

SPAIN ET AL.

Examiner

Cheryl Juska

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 10/01.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claim 1 is rejected under 35 USC 102(e) as being anticipated by US Re. 35,894 issued to Ellison et al.

Applicant claims a process for applying a paint coat to an exterior auto body panel comprising the steps of:

- a. applying a clear resinous film coat onto a casting sheet and drying the coat,
- b. forming a color coat of a pigmented resin to the clear coat and drying,
- c. transferring the dried clear and color coats to a semirigid, resinous backing sheet thereby forming a backing sheet having a composite paint coat thereon, wherein the clear coat forms an exterior surface,
- d. thermoforming the backing sheet and composite paint coat to form a 3-D shaped preformed laminate, and
- e. placing the preformed laminate in a mold and molding a resinous substrate material to form an exterior auto body panel with a finished paint coat.

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The clear coat comprises a material that retains its gloss level sufficient for exterior auto use during the thermoforming step. The backing sheet has sufficient elongation and thickness to absorb defects present in the substrate material, thereby providing an essentially defect-free gloss on the clear coat. The finished composite paint panel provides sufficient appearance and durability properties for use as an exterior auto paint coat.

Ellison teaches a molded plastic article comprising a decorative surfacing film on a bonding layer that can be molded into an auto body part (col. 3, lines 24-33). The decorative surfacing film may be a multilayer film comprised of an outer glossy transparent coat and an underlying colored coat (col. 4, lines 15-23). Additionally, Ellison teaches the presence of a clear outer coat provides a glossy wet look of a base coat/clear coat auto finish (col. 4, lines 17-21).

The Ellison invention is made by placing into a 3-D mold a preformed decorative surfacing film, adding a moldable substrate polymer, and forming into a shaped article with the decorative surfacing film adhered to the outer surface thereof (col. 2, lines 41-50). The decorative surfacing film is formed by casting a polymer film onto a carrier sheet (col. 2, lines 32-40 and col. 3, line 48-col. 4, line 4). The decorative surfacing film, which may include the multilayered clear coat/color coat structure, is then adhered to a bonding layer (col. 2, lines 51-56). Said bonding layer may be a preformed film of a thermoplastic polymer laminated to the inner surface of the cast surfacing film (col. 5, lines 50-67). In deep-drawn, highly contoured finished products, the decorative surfacing film including the bonding layer may be pre-shaped prior to placement into the mold by a vacuum thermoforming process (col. 6, lines 21-29). The bonding layer is of a thickness that ensures good thermoformability, as well as reinforcement,

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stabilizing, and insulating properties, in order to protect the decorative surfacing film from wrinkles and heat distortion that would diminish the glossiness of said surfacing film (col. 6, lines 30-33 and lines 1-29). Therefore, the cited Ellison patent anticipates applicant's claim 1.

[Note it has been previously established during the prosecution of the parent applications that the subject matter relied upon in the cited Ellison reference is given the priority date of October 28, 1986, which pre-dates the present application's effective file date of March 27, 1987.]

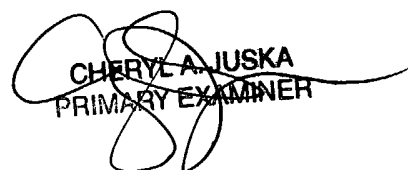
Conclusion

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheryl Juska whose telephone number is 571-272-1477. The examiner can normally be reached on Monday-Friday 10am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached at 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

4. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

cj
March 16, 2004


CHERYL A. JUSKA
PRIMARY EXAMINER